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Akira Nonaka

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EXAMINER

KUCAB, JAMIE R

ART UNIT

PAPER NUMBER

3621

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |                                      |  |
|------------------------------|--------------------------------------|--------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>09/803,396 | <b>Applicant(s)</b><br>NONAKA, AKIRA |  |
|                              | <b>Examiner</b><br>JAMIE KUCAB       | <b>Art Unit</b><br>3621              |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-18,31,33-35 and 50 is/are pending in the application.
- 4a) Of the above claim(s) 50 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-18,31 and 33-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Acknowledgements***

1. Applicant's response filed September 15, 2009 is acknowledged.
2. Claims 1, 3-18, 31, 33-35, and 50 are pending in the application.
3. Claim 50 is withdrawn from consideration.
4. Claims 1, 3-18, 31, and 33-35 are examined below.
5. This Office action is given Paper No. 20100201 for reference purposes only.

### ***Specification***

6. The disclosure is objected to because of the following informalities: the word "hush" is used in numerous places in the drawings and written description. It appears that Applicant intends "hush" to mean "hash." Appropriate clarification or correction is required.

### ***Claim Rejections - 35 USC § 112, 2<sup>nd</sup> Paragraph***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:  

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
8. Claims 1, 3-18, 31, and 33-35 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. Regarding claims 1 and 31, these claims invoke 35 U.S.C. § 112, sixth paragraph, however, the specification does not clearly link the “means” (or equivalent recitations) to corresponding structure. The recitations “an examiner for examining usage space information of the content data, the first medium, the reproducing apparatus, the second medium, and the recording apparatus” (claim 1) and “an examiner for examining usage space information of the content data, the recording medium, and the reproducing apparatus” (claim 31) invoke 35 U.S.C. § 112, sixth paragraph, because the recitation “examiner” is equivalent to a recitation of “means.” The scope of the above two “an examiner for ...” recitations is then limited to the corresponding structures described in the specification. However, the specification does not clearly link corresponding structure to “an examiner.” Nor was such structure implicitly described in the specification in such a manner that it would have been understood by one of ordinary skill in the art at the time of the invention. Therefore, one of ordinary skill in the art at the time of the invention would not be able to determine the scope of the claimed “examiner.” For each of the “examiner for ...” recitations, the Examiner respectfully requests that Applicant (1) identify the corresponding structure and (2) provide specific citations to the portions of the specification that link each of the structures to its respective function.

### ***Response to Arguments***

10. Applicant’s arguments with respect to the objection to the specification over the use of the term “hush function” have been fully considered but they are not persuasive.

Applicant argues that “hush” function is not used mistakenly because “hush” functions exist in the art. Remarks, pgs. 11-12. Applicant presents as evidence of this the statement that “any commonly available search engine reveals that ‘hush’ functions also exist in the art.” First, such a statement is a mere allegation and not evidence that “hush” functions were old and well known at the time of Applicant’s invention and not a typographical error. Second, the Examiner consulted a commonly available search engine and was unable to locate amongst the first ten results returned any usage of a “hush” function that is consistent with Applicant’s usage in the specification. Therefore, this objection to the specification is maintained.

11. Applicant’s arguments with respect to the §112, 1<sup>st</sup> paragraph rejections of the claims have been fully considered and they are persuasive. These §112, 1<sup>st</sup> paragraph rejections of the previous Office action are withdrawn.

12. Regarding the §112, 2<sup>nd</sup> paragraph rejections of claims 1 and 31 due to the recitation “examiner,” after further consideration, the Examiner has concluded that this recitation invokes 35 U.S.C. §112, 6<sup>th</sup> paragraph. Although the claims do not explicitly recite “means,” the presumption that §112, 6<sup>th</sup> paragraph does not apply can be rebutted “by [1] showing that the claim element recite[s] a function [2] without reciting sufficient structure for performing that function.” *Watts v. XL Systems Inc.*, 232 F.3d 877, 880 (CAFC 2000). First, it is clear that each of the claimed examiners includes a function: “[an examiner] for examining usage space information of the content data, the first medium, the reproducing apparatus, the second medium, and the recording apparatus” (claim 1) and “[an examiner] for examining usage space information of the

content data, the recording medium, and the reproducing apparatus” (claim 31).

Second, one of ordinary skill in the art at the time of the invention would not understand “examiner” to denote sufficient structure for performing that function. Although the term “examiner” may denote structure in other fields, in the computer arts “examiner” is “simply a nonce word or a verbal construct that is not recognized as the name of structure and is simply a substitute for the term ‘means for.’” *Lighting World, Inc. v. Birchwood Lighting, Inc.*, 382 F.3d 1354, 1360 (CAFC 2004). As evidence that “examiner” does not denote structure, the Examiner notes that no entry for the word “examiner” can be found in any of the following dictionaries: the *IEEE Standard Computer Dictionary*<sup>1</sup> and the *Newnes Dictionary of Electronics*.<sup>2</sup> Additionally, the Examiner notes that the term “examiner” was substituted for “examining means” in the amendment filed February 19, 2009. Further, in the response filed September 15, 2009, Applicant argues that the specification element “examining means” provides implicit support for the claim element “examiner.” Remarks, pgs. 13-14. Finally, the Examiner has consulted the instant specification and is unable to locate any usage of “examiner” consistent with this element denoting structure. Therefore, the Examiner concludes that “examiner” does not denote structure and is merely a way of describing any device or programming that performs the recited function. As such, “examiner” is equivalent to “means,” and is “construed to cover the corresponding structure, material,

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<sup>1</sup> IEEE Standard Computer Dictionary. New York, The Institute of Electrical and Electronics Engineers, 1990.

<sup>2</sup> Newnes Dictionary of Electronics, 4<sup>th</sup> Ed. Oxford, Elsevier Science & Technology, 1999.

or acts described in the specification and equivalents thereof" in accordance with 35 U.S.C. §112, 6<sup>th</sup> paragraph.

13. Applicant's arguments with respect to the §103 rejections of the claims have been fully considered and they are persuasive. The §103 rejections of the previous Office action are withdrawn.

### ***Conclusion***

14. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Jamie Kucab whose telephone number is 571-270-3025. The Examiner can normally be reached on Monday-Friday 9:30am-6:00pm EST.

15. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer can be reached on 571-272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

16. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jamie Kucab/  
Examiner, Art Unit 3621